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09/784,889	02/16/2001	Richard Joseph Bennett	QDI-107US	5194
7590 Joshua L. Cohen Ratner & Prestia One Westlakes, Berwyn P.O. Box 980, Suite 301 Valley Forge, PA 19482-0980			EXAMINER NAJARIAN, LENA	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

**JUN 21 2007**

**GROUP 3600**

Application Number: 09/784,889  
Filing Date: February 16, 2001  
Appellant(s): BENNETT ET AL.

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Jon E. Gordon  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/11/07 appealing from the Office action mailed 3/3/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 2001/0051880 A1                      SCHURENBERG et al.                      12-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26-34, 49-55, and 60-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Schurenberg et al. (US-2001/0051880 A1).

(A) Referring to claim 26, Schurenberg discloses in a computer network including a client computer and a central computer, a method of receiving an order of a laboratory test of a biological specimen for a patient comprising the steps of (abstract & Fig. 2 of Schurenberg):

receiving, at the central computer, at least one query transmitted through the network from the client computer, the at least one query including a laboratory test request and patient, billing, and diagnosis information corresponding to the requested laboratory test (abstract, Fig. 14, and para. 96 of Schurenberg; the Examiner interprets "requisition" to be a form of "request"); and

transmitting information through the network from the central computer to the client computer, the information including data for generating a test requisition and a label for use with the biological specimen (para. 4, lines 12-16 and para. 55 of Schurenberg).

(B) Referring to claim 27, Schurenberg discloses further comprising the step of analyzing the at least one query at the central computer to verify that the requested laboratory test is payable by a responsible party identified in the billing information (para. 623 & para. 404 of Schurenberg; the Examiner interprets "guarantor" to be a form of "responsible party").

(C) Referring to claim 28, Schurenberg discloses wherein said receiving step comprises receiving a diagnosis code and a laboratory test code as part of the at least one query and said analyzing step comprises searching a code database for correspondence between the diagnosis code and the laboratory test code (para. 20, para. 204, and para. 206 of Schurenberg).

(D) Referring to claim 29, Schurenberg discloses wherein said analyzing step comprises comparing an identified diagnosis and the requested laboratory test to a maximum value to determine whether a maximum number of tests has been exceeded for the identified diagnosis (see table at bottom of page 25 of Schurenberg).

(E) Referring to claim 30, Schurenberg discloses further comprising the step of transmitting a notification through the network from the central computer to the client computer if the requested laboratory test is not payable by the identified responsible

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party for an identified diagnosis (para. 173 of Schurenberg; the Examiner interprets "statement" to be a form of "notification").

(F) Referring to claim 31, Schurenberg discloses further comprising the step of requesting an indication that the patient is responsible for payment in response to the notification (para. 367, para. 368, and para. 404 of Schurenberg).

(G) Referring to claim 32, Schurenberg discloses further comprising the step of transmitting a request for additional diagnosis information through the network from the central computer to the client computer if the requested laboratory test is not payable by the identified responsible party for an identified diagnosis (para. 173 of Schurenberg).

(H) Referring to claim 33, Schurenberg discloses further comprising the step of transmitting a request through the network from the central computer to the client computer for additional information if ask-at-order-entry questions are required for the requested laboratory test (para. 127 of Schurenberg).

(I) Referring to claim 34, Schurenberg discloses said receiving step comprising:

receiving a patient identification at the central computer in the at least one query from the client computer, thereby obtaining information about the patient for whom the test is being ordered (para. 30 of Schurenberg);

receiving billing information at the central computer in the at least one query from the client computer, thereby obtaining information about a party responsible for payment of the test being ordered for the identified patient (para. 19 of Schurenberg); and

receiving a patient diagnosis at the central computer in the at least one query from the client computer, thereby obtaining at least one diagnosis for the identified patient (para. 20 of Schurenberg).

(J) Referring to claim 49, Schurenberg discloses an apparatus for receiving an order of a laboratory test of a biological specimen for a patient comprising:

at least one client computer;

a central computer coupled to exchange data with the at least one client computer;

means for receiving, at the central computer, at least one query transmitted from the client computer, the at least one query including a laboratory test request and patient, billing, and diagnosis information corresponding to the requested laboratory test; and

means for transmitting information from the central computer to the client computer, the information including data for generating a test requisition and a label for use with the biological specimen (abstract, Fig. 2, para. 650, para. 96, Fig. 14, para. 4, lines 12-16, and para. 55 of Schurenberg).

(K) Apparatus claim 50 repeats the subject matter of claim 35 as a set of "means-plus-function" elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Schurenberg in the above rejection of claim 35, it is readily apparent that the Schurenberg reference includes an apparatus to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 35 and incorporated herein.

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(L) Referring to claim 51, Schurenberg discloses an apparatus for ordering a laboratory test of a biological specimen for a patient comprising:

at least one client computer;

a central computer coupled to exchange data with the at least one client computer;

means for transmitting at least one query from the client computer to the central computer, the at least one query including a laboratory test request and patient, billing, and diagnosis information corresponding to the requested laboratory test; and

means, at the at least one client computer for receiving information from the central computer, the received information including data for generating a test requisition and a label for use with the biological specimen (abstract, Fig. 2, para. 650, para. 55, and para. 507 of Schurenberg).

(M) Referring to claim 52, Schurenberg discloses wherein said means for transmitting comprises means for selecting a laboratory test code corresponding to the requested laboratory test from a menu of laboratory test codes (para. 204 of Schurenberg).

(N) Referring to claim 53, Schurenberg discloses further comprising means for customizing the menu of laboratory test codes to include laboratory test codes commonly used by a client (para. 205 of Schurenberg; the Examiner interprets "create" to be a form of "customizing").

(O) Referring to claim 54, Schurenberg discloses wherein said means for transmitting comprises means for selecting a diagnosis code corresponding to an identified



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diagnosis from a menu of diagnosis codes (para. 206 of Schurenberg; the Examiner interprets "ICD-9 code" to be a form of "diagnosis code").

(P) Referring to claim 55, Schurenberg discloses further comprising means for customizing the menu of diagnosis codes to include diagnosis codes commonly used by a client (para. 206 of Schurenberg; the Examiner interprets "add ICD-9 codes" to be a form of "customizing the menu").

(Q) Claims 60-62 differ from claims 26-27 and 32 by reciting "a computer readable medium" and "computer program instructions" within its preamble. As per these elements, Schurenberg's system includes a computer system that utilizes one or more databases (para. 36 & para. 43 of Schurenberg). As such, it is readily apparent that Schurenberg's system includes a computer-readable medium and computer program instructions.

The remainder of claims 60-62 repeat the same limitations of claims 26-27 and 32, and are therefore rejected for the same reasons given above for claims 26-27 and 32, and incorporated herein.

(R) Referring to claim 63, Schurenberg discloses a computer readable medium including computer program instructions that cause a client computer in a computer network including the client computer and a central computer, to perform a method of ordering a laboratory test of a biological specimen for a patient, the method comprising the steps of (para. 36, para. 43, Fig. 2, and abstract, lines 1-5 of Schurenberg):

transmitting at least one query through the network to the central computer, the at least one query including a laboratory test request and patient, billing, and diagnosis

information corresponding to the requested laboratory test (abstract of Schurenberg);  
and

receiving information through the network from the central computer, the  
received information including data for generating a test requisition and a label for use  
with the biological specimen (para. 507 and para. 55 of Schurenberg; the Examiner  
interprets "add...lab test requisitions" to be a form of "generating").

#### **(10) Response to Argument**

In the Appeal Brief filed 11 April 2007, Appellant makes the following arguments:

A) The distributed computer system in Schurenberg is not the central computer  
system of claim 26.

B) Schurenberg fails to disclose or suggest transmitting information to the client  
computer including data for generating a test requisition.

C) Schurenberg fails to disclose or suggest transmitting information to the client  
computer including data for generating a label for use with a biological specimen.

D) Claim 27 is allowable because Schurenberg fails to disclose or suggest  
"analyzing the at least one query...to verify that the requested laboratory test is payable  
by a responsible party identified in the billing information," as claim 27 sets forth.

E) Claim 28 is allowable because Schurenberg fails to disclose or suggest  
analyzing that comprises searching a code database for correspondence between the  
diagnosis code and the laboratory test code, as claim 28 sets forth.

F) Claim 29 is allowable because Schurenberg fails to disclose or suggest comparing an identified diagnosis and the requested laboratory test to a maximum value to determine whether a maximum number of tests has been exceeded for the identified diagnosis, as claim 29 sets forth.

G) Claim 32 is allowable because Schurenberg fails to disclose or suggest “transmitting a request for additional diagnosis information...to the client computer if the requested laboratory test is not payable by the identified responsible party for an identified diagnosis,” as claim 32 sets forth.

Examiner will address Appellant’s arguments in sequence as they appear in the brief.

Argument A:

In response to Appellant’s first argument, the Examiner gave each term the broadest reasonable interpretation in light of the Applicant’s specification. Words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the Appellant. Where an Appellant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with “reasonable clarity, deliberateness, and precision” in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*,

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273 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP § 2111.01.

Pursuant to 35 USC § 112, 2<sup>nd</sup> paragraph “[i]t is Appellant's burden to precisely define the invention, and not the [examiner's].” *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Therefore, it would not be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined by the Appellant in the written description.

In this case, Appellant argues that the “middleware server” is not a “central computer” (pages 5-6 of Appeal Brief). The Examiner respectfully submits that Appellant points to definitions of middleware and states, “nothing in either definition suggests that a server hosting middleware is a ‘central computer’ within the meaning of claim 26.” All Appellant is arguing is that the “middleware server” is not a “central computer,” yet there is no special definition of a “central computer.” For these reasons, Appellant’s claims were given their broadest reasonable interpretation consistent with the specification, and the Examiner applied prior art accordingly.

#### Arguments B and C:

In response to Appellant’s second and third arguments, the Examiner respectfully submits that all that is claimed is a step of transmitting information. It is noted that the features upon which applicant relies (i.e., that the transmission takes place before a test requisition has been generated) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also, the claim does not specify when or if the label is printed.

Argument D:

In response to Appellant's fourth argument, the Examiner respectfully submits that para. 404 of Schurenberg teaches "the Guarantors page of the Patient Details window...lists the person(s) *responsible* for payment...." As such, it is readily apparent that a responsible party has been identified. In addition, para. 623 of Schurenberg states "a lab identifies a payer by a billing ID." Additional portions of Schurenberg that expressly disclose "verification" include paragraphs 27 (i.e., "electronic verification of patient insurance eligibility" and 622 (i.e., "claims and eligibility verification").

Argument E:

In response to Appellant's fifth argument, the Examiner respectfully submits that paragraphs 86 and 123 of Schurenberg disclose that each requisition record includes both the diagnosis and lab test codes. As such, it is readily apparent that there is a correspondence between the two. In addition, paragraph 154 of Schurenberg discloses the ability to search the requisitions.

Argument F:

In response to Appellant's sixth argument, Schurenberg discloses that the requisition includes a diagnosis (note abstract of Schurenberg). Schurenberg then

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teaches a field that identifies the maximum number of tests per requisition (see table at bottom of page 25 of Schurenberg). As such, it is readily apparent that Schurenberg discloses the maximum number of tests corresponding to a diagnosis.

Argument G:

In response to Appellant's seventh argument, the Examiner respectfully submits that paragraph 100 of Schurenberg discloses, "when the bill type chosen is Third Party and the patient insurance is for a Medicare payer and the user selected a test code that is not LCP-compliant or FDA-approved, the ABN Dialog box appears." Paragraph 103 discloses allowing the user to "select appropriate ICD-9 Diagnosis Codes for the selected tests" (i.e., additional diagnosis information). As such, it is readily apparent that Schurenberg discloses transmitting a request for additional diagnosis information if the requested laboratory test is not payable by the identified responsible party.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


  
Lena Najarian


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LN

May 31, 2007

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